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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,129	11/27/2000	Dieter Dohring	TURKP0114US	4043

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10/22/2002

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 10/22/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/647,129	<b>Applicant(s)</b> DOHRING, DIETER	
	<b>Examiner</b> Elena Tsoy	<b>Art Unit</b> 1762	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-8

Claim(s) withdrawn from consideration: 9-11

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

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*Advisory Action*

1. The amendment filed on October 16, 2002 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment of claim 5 includes limitations all of which were recited in original claims 5, 6 and 7 and were already searched and addressed in the Final Office Action mailed on August 12, 2002 (Paper No. 9).

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3, 8** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Michl (US 3,135,643) in view of Fischer et al (US 6,0231,670) and Hosler (US 4,505,974) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on August 12, 2002 (Paper No. 9).

4. **Claims 2, 4** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Michl (US 3,135,643) in view of Fischer et al (US 6,0231,670) and Hosler (US 4,505,974), as applied above, and further in view of O'Dell et al (US 5,545,476) and Hoover et al (US 2,958,593) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on August 12, 2002 (Paper No. 9).

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5. **Claims 5-7** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Michl (US 3,135,643) in view of Fischer et al (US 6,0231,670) and Hosler (US 4,505,974), as applied above, and further in view of Lindgren et al (US 5,034,272) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on August 12, 2002 (Paper No. 9).

***Response to Arguments***

6. Applicant's arguments filed on October 16, 2002 have been fully considered but they are not persuasive.

(A) Applicants argue that Fischer et al cannot be qualified as prior art because of the date and therefore, the rejection is improper.

The Examiner respectfully disagrees with this argument. Metering rollers recited in the claims are not novel feature of claimed invention. It is well known in the paper art that metering rollers are squeezing rollers, which are conventionally used for removing an excess of a resin from a paper web (impregnated with the resin) to a predetermined final resin amount by setting the metering rollers at a predetermined final mass before application of another coating.

In other words, **even without citing Fischer et al** the use of metering rollers in a paper coating process (comprising steps of taking paper, damping and impregnating said paper with a resin by the use of metering rollers, then applying another coating onto the damped paper) would have been obvious to one of ordinary skill in the art since they are *conventionally* used in a paper coating process. However, Fischer et al still can be used as a proper reference since it cites Swiss Patent 432,818 having publication date of 1965 (See BACKGROUND OF THE INVENTION, column 1, lines 23-35), which teaches the use of squeezing (metering) rollers in a paper coating

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process comprising claimed steps such as taking paper, damping and impregnating said paper with a resin with the use squeezing (metering) rollers, then applying another coating onto the damped paper (See column 1, lines 23-35).

Thus, the rejection of claims over Michl (US 3,135,643) in view of Fischer et al (US 6,023,670) and Hosler (US 4,505,974) is proper.

(B) Applicants argue that the skilled person would not be motivated to use an abrasive material of 60-160 microns in the performance of methods taught by Michl and Hosler; and no such a motivation can arise from Lindgren et al as relating to a significantly different process than those disclosed by Michl and Hosler.

The Examiner respectfully disagrees with this argument. First of all, method of Hosler is irrelevant because Hosler is cited merely as evidence for spraying being functionally equivalent to knife coating of Michl. Secondly, a process of Lindgren et al is not significantly different from a process disclosed by Michl offering a process, which allows avoiding the use of overlay customary in prior art, since Lindgren et al relate to both methods: prior art method with an overlay and a method of Michl without the use of overlay (See column 2, lines 5-19).

Michl acknowledges that abrasive material in coating compositions of prior art, which conventionally has particles of size larger than particle size of less than 6 microns in Michl, does improve abrasion resistance, but usually renders deficiencies such as poor print clarity, poor craze resistance, etc. (See column 1, lines 47-70). Lindgren et al teach that how to avoid deficiencies of prior art laminates such as poor print clarity, etc. while using abrasive material having the average particle size within the claimed range (if the average particle size is too small, particles give too low abrasion resistance, if it is too big, the surface of the laminate is rough and

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unpleasant, so the average particle size should be in the range of 1-80 microns) (See column 2, lines 54-68; column 3, lines 30-35, 64-69). For these reasons Lindgren et al would clearly motivate the skilled person to use abrasive material having the average particle size larger than that of Michl in both methods: prior art method with an overlay and a method similar to that of Michl without the use of overlay since it would provide paper laminates with extremely increased abrasion resistance, and at the time would allow to eliminate deficiencies of prior art mentioned by Michl and Lindgren et al.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy  
Examiner  
Art Unit 1762

October 18, 2002



**MICHAEL BARR**  
**PRIMARY EXAMINER**